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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,250	11/14/2003	Jewel L. Dohan	10014.0001US	2472

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EXAMINER

HALE, GLORIA M

ART UNIT PAPER NUMBER

3765

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/714,250	DOHAN, JEWEL L.	
	Examiner	Art Unit	
	Gloria Hale	3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Reconsideration of 6-14-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Relyea (US 4,594,276).

In regard to claims 1-3, 16 and 18-20 Relyea discloses reusable adhesive body apparel with a substantially flat decorative component when worn on a flat surface with a decorative image and with a reusable adhesive component. Relyea discloses the uneven surface topography, wherein the medical grade tape material used is reusable and is removable without pain to the wearer and with the adhesive laminated to the tape material. (See Relyea, col. 2, line 1 – col. 3, line 58 and col. 4, lines 32-39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Relyea (US 4594276) in view of Felton et al (US 6207874).

Relyea discloses the invention substantially as claimed except for the printed design image as being digital. Felton et al discloses the printed design on a tattoo patch as being digital. (See Felton et al (col. 4, line 52).

Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Relyea (US 4594276) in view of Limburg et al (US 6,604,854).

Relyea discloses the invention substantially as claimed wherein the image is any printed image of any object as desired by the maker. However, Relyea does not specifically disclose the image/design as being one of the e specific designs/images listed.

Limburg et al discloses the claimed image/objects/designs as claimed. Accordingly it would have been obvious to construct the tattoo of Relyea in any known image design which would have only been limited by the imagination of the user. (See Limburg et al col. 2, lines 24-33.

Claims 6,7,12,14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Relyea (US 4,594,276) in view of Applicant's Own Disclosure/Admission Of Known Adhesives.

Relyea discloses the invention substantially as claimed including the surgical tape material which is elastic, non-woven and which permits gas flow. However, Relyea does not disclose the specific water soluble, hydrogel adhesive. (See Relyea, col. 2, line 24 – col. 3,line 4). Applicant's own disclosure on page 9, lines 7-20 discloses the

well known use of hydrogel adhesives. The Examiner takes Official Notice that it is common knowledge to use hydrogel adhesives on bandages and other body adhered materials since they are hypo-allergenic and perform well when attaching bandages or other medical attachments to a user's body such as patches that transmit medicine to a wearer some of which have printed names. Tradenames or instructions printed on the clear film outer surface as applicant's imitation tattoo. Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the adhesive of Relyea with any known adhesive such as the known hydrogel adhesive listed in applicant's specification to achieve the known benefits of the hydrogel adhesive during use such as its hypoallergenic nature and comfort to the wearer in addition to its adhesive characteristics.

In regard to claim 12 Relyea does not specifically disclose the adhesive layer thickness as claimed. The thickness of Relyea has a nominal thickness. Finding the optimum exact thickness as claimed would have been within one of ordinary skill in the art which would have been found through routine experimentation to achieve a desired result such as thick enough to perform the desired adhesive qualities without being overly thick to inhibit the aesthetic effect as desired.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Relyea in view of Dodge (US 6,371,831).

Relyea discloses the invention substantially as claimed. However, Relyea does not specifically disclose the tattoo apparel as having an opening in the adhesive

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component to provide a non-adhesive region, the opening located near the center of the apparel and dimensioned to cover a nipple or that the apparel is a swimsuit. Dodge discloses a swimsuit patch with the non-adhesive (16), adhesive opening (16) in the center of the apparel for locating over the nipple of a wearer so that the nipple is not irritated when the apparel is worn. (See Dodge- figures 1 and 8 and col. 2, lines 35-43; col. 4, lines 16, 35-37). Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the Relyea tattoo patch in the shape of a breast covering swimsuit with the opening, non-adhesive area in the central area to cover the nipple of the wearer to achieve a desired aesthetic effect while covering a wearer's nipple without having the adhesive irritate the wearer's nipples while worn.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Relyea in view of Dodge and applicant's Own Disclosure/Admission in Regard to Known Adhesives.

Relyea disclose the invention substantially as claimed. However, Relyea does not disclose the adhesive and non-adhesive surface areas with the use of a hydrogel adhesive. Dodge discloses the adhesive and non-adhesive areas as claimed and applicant's own disclosure describes the use of known hydrogel adhesives as discussed above in regard to claims 8-11 and 14. Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the tattoo patch structure of Relyea with the teachings of Dodge and applicant's own disclose that

hydrogels are well known and widely used adhesive for the same reasons as discussed above in regard to claims 8-11 and 14.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

Applicant's arguments filed 6-14-04 have been fully considered but they are not persuasive.

Nothing in the Relyea Patent or the Copeland patent of which Relyea discloses as the adhesive Relyea uses on their tattoo discloses that the adhesive must be removed by rubbing alcohol or baby oil. The Felton et al patent also does not state that the Relyea and Copeland adhesive must be removed by alcohol or baby oil. The lines applicant's representative is referring to within the Felton patent in col. 3, lines 32-33 is

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not specifically referring to the Relyea or Copeland patent but is referring to their own invention since it is in the "Summary of the Invention" and that he prefers that the adhesive used in his device is removed with oil or alcohol. Any inference that the Relyea or Copeland adhesive must be removed by alcohol or oil is incorrect. The Relyea patent does not state that any such methods of removal must be used. The Copeland adhesive patent states that the adhesive is hydrophobic to basic perspiration but with perspiration that is more than that under ordinary conditions the adhesive will soften and swell such as "upon prolonged contact with liquid perspiration". The adhesive of Copeland on medical tapes and as used in Relyea is re-usable as applicant has broadly claimed. The present claims only generally claim that the adhesive apparel is re-usable without any stipulation as to the conditions of the usage. The Relyea device can be used, removed and re-applied as broadly claimed. It can be removed and re-used for any amount of time period whether it is from one minute or more as desired by a user, removed and re-applied for re-use. Nothing in Relyea or Copeland which discloses the adhesive used indicates that the tattoo cannot be removed, re-positioned and re-used. The language referred to in the Fulton patent is not referring to the Relyea patent but rather the Fulton invention. Applicant's own disclosure has indicated the well known use of hydrogel adhesives which are widely used in medical patches such as smoking cessation patches, Transcutaneous Electronic Nerve Stimulator patches and other patches for medicinal transmission such as birth control. The common substitution of one known adhesive for another to achieve a desired known end use such as the adhesion of the patches which are well


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known to be adhered with hydrogels would have been obvious to one of ordinary skill in the art. It is also well known that medicinal hydrogel patches often contain tradenames thereon or warning labels about the transparent material which is similar to a tattoo design since it is printed matter on a transparent hydrogel attachable patch.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 703-308-1282. The examiner can normally be reached on Tuesday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gloria Hale
Primary Examiner
Art Unit 3765
